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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,945	11/04/2003	James J. Mallozzi	Hartford-13B	7123
45722	7590	12/03/2008	EXAMINER	
Howard IP Law Group P.O. Box 226 Fort Washington, PA 19034			CAMPEN, KELLY SCAGGS	
			ART UNIT	PAPER NUMBER
			3691	
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			12/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/701,945

Applicant(s)

MALLOZZI, JAMES J.

Examiner

KELLY CAMPEN

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-13 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following is in response to the Amendment filed 8/7/2008, claims 1-6,8-9,11,13,15,16-20 are pending, claims 21-29 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagan US 5864685).

Hagan discloses a data processing system, associated method and associated computer readable medium for managing a financial services configuration including a legal entity issuing shares of nonvoting stock, receiving payment from one or more owners of the issued shares, establishing one or more financial sub accounts for each owner, each owner having control of allocations of proceeds of issued shares into one or more selected investment funds comprising (col 1, lines 50-col 2 line 20), a processor; a data storage device; wherein the processor is adapted to; store data concerning the legal entity, the one or more owners and the funds; calculated an initial net asset value for each sub account based on the amount of the proceeds applicable charges, and the investment allocation; receive investment fund value increase or decrease data; (col. 5, lines 67) and allocate investment fund value increase or decrease data to the sub accounts in accordance with the investment allocations, to determine and updated net

asset value for each of the sub accounts, and output a signal indicative of the updated net asset value (col 4 lines 50-65, col 6 lines 35-45, col 9, lines 20-30, see abstract, figures 2, 3a, 4, 5 col. 6, lines 35-60) [claims 1, 16, 20].

Specifically as to claim 2, displaying the current value, inherently, the value will be displayed prior to printing, see figure 4.

Specifically as to claim 3, printing the current value (see figure 4).

Specifically as to claim 4, the sub account includes a segregated account (figure 9).

Specifically as to claims 6 and 17, means to retrieve fund information and calculate the info for an owner and to display and provide the means to calculate (col 4, lines 50-67).

Specifically as to claim 18, investment funds are a family of funds with a death benefit (within the scope of the term “life insurance”) (see col 4, lines 50-67).

Specifically as to claims 8 and 19, the investment funds have the protection element of a death benefit that assures the beneficiaries of particular values (see col. 4, lines 50-67).

Specifically as to claim 9, maintenance fee charges (see col 6, lines 10-15 as maintenance fees are inherent fees in investing).

Specifically as to claim 11, an administrative charge, (see col 6, lines 10-15 as administrative charges are inherent fees in investing).

Specifically as to claim 12, admin fee is deductible as an expense, (see col 6, lines 10-15 as administrative fee is deductible as an expense is inherent fees in investing).

Specifically as to claim 13, contingent deferred sales charge (see col 6, lines 10-15 as contingent deferred sales charge are inherent charges in investing as this is a matter of design choice).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagan (US 5864685) as applied above and further in view of Schirripa (US 6275807).

Specifically as to claim 5, Hagan discloses a data processing system, associated method as applied in the above rejection but does not specifically disclose including a means to retrieve fund information and calculate that information for an owner of a beneficial right and aggregate on an owner by owner of a beneficial right basis and to display for a corresponding owner of a beneficial right a current value of the owner of a beneficial right separate account within the segregated account and provide the means to calculate the amount due in respect of a death benefit and a living benefit.

Schirripa discloses a financial system being used to calculate values for benefits.

It would have been obvious to one of ordinary skill in the art to include in the financial system of Hagan the ability to calculate the value as taught by Schirripa since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specific lay as to claim 15, Hagan discloses a data processing system, associated method as applied in the above rejection but does not specifically disclose wherein the value of an instrument evidencing ownership is the sum of a financial units allocated to a sub account corresponding to an underlying sub account fund multiplied by the unit value for an investor's sub account.

Schirripa discloses a financial system being used to calculate values for benefits.

It would have been obvious to one of ordinary skill in the art to include in the financial system of Hagan the ability to calculate the value as taught by Schirripa since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicant's amendments have overcome the following rejections/objections:

The Objection to the Specification, specifically the Abstract, has been overcome by amendment and is therefore withdrawn.

The Objection to claims 1-3, 9 and 13 have been overcome by amendment and are therefore withdrawn.

The rejection of claims 1-15 under 35 USC 112 second paragraph have been overcome by amendment and are therefore withdrawn.

In response to Applicant's argument that Hagan fails to disclose a system for administration of a financial services configuration including a legal entity issuing non voting shares, and providing investment discretion over the proceeds in the owners of the shares and purchasing shares of an entity, Examiner disagrees.

In response to applicant's arguments, the recitation system for administration of a financial services configuration including a legal entity issuing non voting shares, and providing investment discretion over the proceeds in the owners of the shares has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., investment discretion in the subscriber and *purchase* of shares of an entity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/
Examiner, Art Unit 3691